REMARKS AND ARGUMENTS

There are no amendments to the specification or drawings.

There are no amendments to the Claims.

Claims 1-4 are pending in this application.

A. Rejection of Claims 1-4

Claims 1-4 stand rejected under the judicially-created doctrine of obviousness-type double-patenting over Claims 1-24 of U.S. Patent No. 6419578.

Applicant submits that this rejection is not proper. The Examiner takes the position that "the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a poker method."

Notwithstanding the Examiner's misstatement of the law of obviousness-type double-patenting [see In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970)], the inventions set out in Claims 1-4 of the instant application are not fully disclosed in the '578 patent. Furthermore, the question of obviousness-type patenting depends on the claimed subject matter of the earlier '578 patent

as compared to the claimed subject matter of Claims 1-4 of the instant application.

The present inventions as set out in Claims 1-4 are directed at providing a first pay table and playing a first hand of video poker. If the final poker hand after the hold and draw step results in a winning combination, the player may then parlay all or some of his winnings into a second round of play using a second pay table that has a different overall game return than the first pay table.

Claims 1-24 of the '578 patent claim various inventions related to awarding the player various bonus events based on the preselected arrangement of cards of the player's initial five card hand. There is nothing in the claimed inventions of Claims 1-24 of the '578 that make any bonus event determinations based on the final five card hand of the player.

There is no basis in the claimed inventions of Claims 1-24 of the '578 patent for teaching or suggesting that the various methods of play set out in Claims 1-24 of the '578 patent could be modified to use the player's final five card hand to determine whether various bonus events may be awarded to the player.

Since the Examiner has not made a prima facie case that it would have been obvious to modify any of the methods of play of

Claims 1-24 of the '578 patent to use the player's final five card hand to determine whether various bonus events may be awarded to the player, the rejection of Claims 1-4 under the judicially-created doctrine of obviousness-type double patenting is not proper and should be withdrawn.

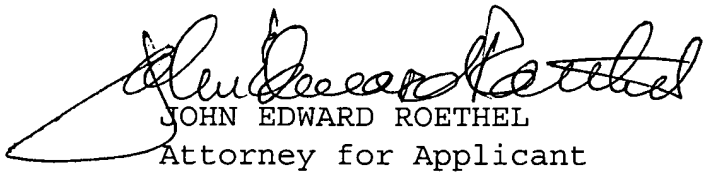
B. *Comment regarding marking of patent copy*. *As part of the Office Action, a copy of U.S. Patent No. 6419578 was provided. The copy included yellow magic markings on various portions of the patent. Presumably this yellow magic marking was made by the Examiner. Counsel would request that the Examiner's practice of yellow magic marking of the patent copy be discontinued. Should litigation eventually occur regarding this application, an issue may arise as to who made the yellow magic marking and why. If the Examiner feels constrained to direct counsel to particular portions of the patent, it is suggested that reference be made directly in the text of the Office Action.*

C. Conclusion.

Applicant submits that all of the claims pending in this application, Claims 1-4 are allowable and the Examiner is requested to reconsider the rejections of Claims 1-4 and to find

that these claims are now allowable. If the Examiner has further questions regarding this application, the Examiner is requested to call undersigned counsel.

Respectfully submitted,



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